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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 51

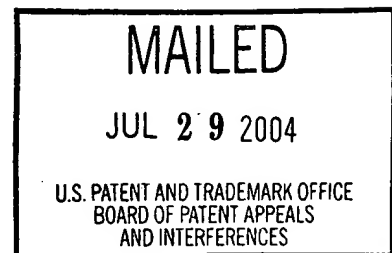
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL C. SCROGGIE, DAVID A. ROCHON,
DAVID W. BANKER and WILL GARDENSWARTZ

Appeal No. 2004-1267
Application No. 08/873,974

ON BRIEF



Before KRASS, FLEMING and DIXON, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the rejection of twice-rejected claims 50-89.

The invention is directed to a system, process and computer program product for distributing product incentives to consumers over a communication network.

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Representative independent claim 50 is reproduced as follows:

50. A system for distributing product incentives to consumers over a communication network, comprising:

a cooperative network site configured to store at least one of (i) manufacturer incentives to purchase one of a product and a service offered by a manufacturer and (ii) retailer incentives to purchase one of a product and a service offered by a retailer;

at least one of a manufacturer network site and a retailer network site coupled to said cooperative network site via said communication network; and

a consumer computer coupled to one of said manufacturer network site and retailer network site via said communication network,

wherein said cooperative network site is configured to transmit at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request made over said communication network from one of said manufacturer network site and retailer network site.

The examiner relies on the following references:

Sloane	5,918,211	Jun. 29, 1999
		(filed May 30, 1996)

Narasimhan et al. (Narasimhan)	6,237,145	May 22, 2001
		(filed Aug. 14, 1996)

Claims 50, 51, 60, 61, 70, 71, 80 and 81 stand rejected under 35 U.S.C. § 102(e) as anticipated by Sloane.

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Claims 52-59, 62-69, 72-79 and 82-89 stand rejected under 35 U.S.C. § 103 as unpatentable over Sloane in view of Narasimhan.¹

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

At the outset, we note that while appellants devote eleven pages in the Third Supplemental Brief, filed December 23, 2002, to arguing a rejection under 35 U.S.C. § 112, first paragraph, there is no such rejection on appeal herein since the examiner has made no such rejection in the answer. Accordingly, we consider only the prior art rejections under 35 U.S.C. § 102(e) and § 103.

Independent claims 50, 60, 70 and 80 all stand rejected as being anticipated by Sloane.

Taking claim 50, as exemplary, the examiner applies Sloane as follows:

¹While claim 54 is included in the statement of rejection under 35 U.S.C. § 103, at page 5 of the answer, we note that the examiner includes this claim in the rejection under 35 U.S.C. § 102(e) in the explanation of the issues at page 2 of the answer. We will assume that the rejection of this claim is, in fact, under 35 U.S.C. § 103, as that is what the statement of rejection indicates.

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The "cooperative network site..." is said to be taught at column 7, lines 22-26, of Sloane. The "at least one of a manufacturer network site and a retailer network site coupled to said cooperative network site via said communication network" is said to be taught by Sloane at column 7, lines 13-17. The "consumer computer..." is said to be taught by Sloane at Figures 4 and 5, where the consumer computer is represented as the portable bar code scanning device. Finally, the wherein clause, "wherein said cooperative network site is configured to transmit at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request..." is said to be taught by Sloane at column 7, line 65 through column 8, lines 7, and at column 8, lines 44-48.

Appellants' response to this rejection appears in the Supplemental Appeal Brief, filed April 11, 2001.

Appellants argue that whereas the instant invention is directed to distributing product incentives to consumers over a communication network, including a consumer computer coupled to various network sites, Sloane is concerned with providing incentives to consumers at a point-of-purchase in a retail store.

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We do not find this argument to be persuasive. Clearly, the network over which the sender, or manufacturer, sends the incentives to the retailer is a "communication" network. While even appellants admit that the processing of incentives between a retailer (or product manufacturer) and a retailer computer/controller 12 is performed over a "communication" network (see Supplemental Appeal Brief of April 11, 2001-page 8), appellants argue that Sloane fails to disclose or suggest distributing product incentives to consumers over a communication network.

Again, we are not persuaded by this argument. While appellants may envision sending the incentives directly to consumers at their home computers, in this regard, the claims require only that there is a "consumer computer" coupled to one of the retailer or manufacturer network sites and that the incentives are transmitted to the consumer over the communication network and in response to a consumer request made over the network. It is our view that Sloane clearly teaches as much. As the examiner indicates, at page 4 of the answer, the "consumer computer" in Sloane may be the hand-held scanning device which the consumer carries through the store.

First, we have already established that the transmissions in Sloane are performed over a "communication network."

Further, in Sloane, a sender of promotional information sends the information to the retailer computer/controller (column 7, lines 13-14). Thus, incentives are provided over a communication network. Then, the consumer is eventually given the promotion, or promotional price, on a given product through a wireless communication network, as the scanner (i.e., "consumer computer") offers the consumer the discount or promotion (note column 8, lines 1-7)².

While one might argue that the promotion is not transmitted *directly* to the consumer computer in Sloane, the promotion is clearly transmitted, at least *indirectly*, to the consumer, and this is all that is required by the instant claims. Moreover, any promotion or discount offered in Sloane is clearly "in response to a consumer request." Not only does Sloane indicate in the Background section that it was known for consumers to

²We note, further, the disclosure of Sloane, in the background section of the document, at column 2, lines 19-20, wherein it is disclosed that there were well known methods of issuing electronic coupons to consumers or promotions to consumers which include "consumer requested promotion/coupons through the use of their home computer and an online computer network."

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request coupons over the internet, even in Sloane's actual invention, a consumer first locates and scans a related product required for a promotion and then the discount is taken (see column 8, lines 45-49).

Having determined that the examiner has set forth a prima facie case of anticipation and that appellants have failed to overcome such case by any convincing argument, we will sustain the rejection of claims 50, 51, 60, 61, 70, 71, 80 and 81 under 35 U.S.C. § 102(e).

Turning now to the rejection of claims 52-59, 62-69, 72-79 and 82-89 under 35 U.S.C. § 103, the examiner cites Narasimhan (specifically, column 4, lines 62-65, and column 8, lines 4-13) as providing for the deficiency, in Sloane, of disclosing, as in claim 52, for example, "wherein, in response to a query from said consumer made over said communication network from said manufacturer network site, said cooperative network site transmits a geographically limited list of retailers honoring incentives from said manufacturer and corresponding incentive data to said consumer...."

It is the examiner's position that it would have been obvious to provide such a list of geographically limited retailers so as to give the consumer "the ability to customize

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and control his or her purchase preferences by location" (answer-page 5).

Appellants' Supplemental Appeal Brief, filed April 11, 2001, says nothing about this rejection based on Narasimhan, referring only to a rejection based on a patent to Allsop, together with Sloane. Similarly, neither appellants' Appeal Brief, filed March 2, 2001, nor the Third Supplemental Brief, filed December 23, 2002, says anything about this rejection. Accordingly, nothing therein is persuasive of any error on the examiner's part in rejecting the claims under 35 U.S.C. § 103 over Sloane and Narasimhan.

In fact, we have nothing responsive to the examiner's specific rejection under 35 U.S.C. § 103 until the Reply Brief, filed April 22, 2003, at which point appellants present no argument regarding the merits of the examiner's rejection, preferring, instead, to attack the examiner's rejection under 35 U.S.C. § 103, based on the combination of Sloane and Narasimhan, by attacking it procedurally. More particularly, appellants argue that this constitutes a new ground of rejection which is prohibited by 37 CFR 1.193 (a)(2).

We have reviewed the record of this case and it appears that the rejection under 35 U.S.C. § 103, based on Sloane and

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Narasimhan, is not a new ground of rejection as to claims 52, 53, 55-59, 62, 72 and 82, the rejection in the Answer appearing substantially the same as a rejection of those claims in Paper No. 45 (page 9), mailed September 23, 2002.

However, the rejection of claims 54, 63-69, 73-79 and 83-89 under 35 U.S.C. § 103, appearing in the answer, does constitute a new ground of rejection because the rejection of these claims on this ground does not appear in Paper No. 45.

Accordingly, we will summarily sustain the rejection of claims 52, 53, 55-59, 62, 72 and 82 under 35 U.S.C. § 103 because the examiner seems to have stated a reasonable case for a finding of obviousness, which has not been rebutted by appellants in any substantive manner. We note, however, that our affirmance of this rejection is pro forma, and not based on substantive arguments since appellants have presented no substantive arguments with regard to this rejection.

With regard to the rejection of claims 54, 63-69, 73-79 and 83-89 under 35 U.S.C. § 103, this is a new ground of rejection, not permitted under 37 CFR 1.193 (a)(2). Accordingly, with regard to the rejection of these claims, we remand the application to the examiner to either withdraw the rejection or reopen prosecution, giving appellants an opportunity to respond

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to the new ground of rejection if it is to be applied.

Since we have sustained the rejection of claims 50, 51, 60, 61, 70, 71, 80 and 81 under 35 U.S.C. § 102(e) and the rejection of claims 52, 53, 55-59, 62, 72, and 82 under 35 U.S.C. § 103, the examiner's decision is affirmed.

The application is also remanded to the examiner for action consistent with the reasoning herein with regard to the rejection of claims 54, 63-69, 73-79 and 83-89 under 35 U.S.C. § 103.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

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This application, by virtue of its "Special" status, requires an immediate action, MPEP 708.01 (8th ed., August, 2001).

AFFIRMED AND REMANDED

Ernst H. Krum

ERROL A. KRASS
Administrative Patent Judge

Michael B. Fleming
MICHAEL B. FLEMING

MICHAEL R. FLEMING /
Administrative Patent Judge

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